

Serial No. 09/749,227

Page 3

REMARKS

In the Office Action of April 22, 2003, the Examiner finally rejected the claims 1-6 and 15 as reciting subject matter not described in the specification and as indefinite. The Examiner further finally rejected claims 1-6, 9 and 15 as either anticipated, or obvious, over Reedhead.

The Applicants respectfully traverse the present rejections.

The Section 112 Rejections

With respect to the section 112, first paragraph rejection, the Applicants respectfully submit that the Examiner has not proffered a *prima facie* showing that the subject matter of the claims is not sufficiently described in the specification as originally filed. While the Examiner asserts that "there is no description in the originally filed specification of strings being in a non-distorted shape", the Applicants respectfully submit that this assertion is without foundation and is in error.

In the first instance, the limitation to which the Applicants believe the Examiner is referring is that the frame is not distorted. *See, e.g.*, claim 15. That limitation is well supported by the specification as originally filed. For instance, the Applicants note the Abstract clearly states: "a double diagonal stringing pattern such that the original shape of the racket frame is not distorted". (Emphasis added). *See also* paragraphs 0003 and 0014 of the specification as originally filed.

Consequently, the section 112, first paragraph rejection must be withdrawn.

With respect to the Examiner's asserted indefiniteness rejection, the Applicants respectfully note that the Examiner has not made a *prima facie* showing that one of ordinary skill can not ascertain the metes and bounds of the claimed subject matter using the specification as a guide. Indeed, the Applicants respectfully submit that one of ordinary skill following the directions given in the present specification would clearly understand the metes and bounds of the claimed subject matter. Thus, this rejection must also be withdrawn.

The Prior Art Rejections

The Applicants also traverse the prior art rejections for at least three reasons. First, the present rejection was made final even though the present rejection is the first time the Examiner applied Reedhead to an unamended claim in the present application. Second, the

Serial No. 09/749,227

Page 4

present rejection is predicated upon the Examiner's beliefs, but those beliefs are without a proper evidentiary basis. Thirdly, it appears that the Examiner has misconstrued both the cited art and the rejected claims.

The Applicants respectfully note that the July 15, 2002 Amendment did not necessitate the new grounds first presented in this rejection. Rather, the Applicants respectfully submit that the Examiner's interpretation of the Reedhead patent was equally applicable to the claims prior to the July 15, 2002 Amendment. Indeed, claim 9 was not amended, therefore the absence of an amendment to claim 9 cannot be said to have necessitated a new grounds of rejection of this unamended claim. In sum, the July 15, 2002 Amendment did not necessitate the new grounds. Therefore, the Applicants respectfully request that the finality of the present rejection be withdrawn.

The Applicants also note that the present rejection is based upon the Examiner's "beliefs". Specifically, the Applicants note that in paragraph 7, the Examiner states:

It is further believed that given a sufficiently low tension, both the frame and strings would be in a non-distorted shape.

The Applicants submit that:

It is never appropriate to rely solely on "common knowledge" [or beliefs] in the art without evidentiary support in the record . . . *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697 ("[T]he Board cannot simply reach conclusions based on its own understanding or experience-or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings."). Manual of Patent Examiner Procedures § 2144.03.

In theory, the Examiner could cure this defect with an affidavit setting forth the basis of his beliefs. Here, however, as shown below, the Examiner's beliefs are contrary to the express teachings of the Reedhead patent. Therefore, the Examiner's beliefs do not support a *prima facie* basis for either of the present rejections. Thus for this further reason, the present rejections must be withdrawn and the claims allowed.

Serial No. 09/749,227

Page 5

The Applicants further respectfully submit that when the cited art and the rejected claims are properly construed, the claimed subject matter is neither anticipated nor obvious. Thus, the present rejection must be withdrawn and the claims allowed.

Claims 1-3 and 15 are not Anticipated by the Reedhead patent

Notwithstanding the Examiner's belief that the Reedhead patent teaches a sufficiently low tension so that both the frame and strings are in a non-distorted shape, the reference does not contain such a teaching. Instead, to the contrary, the Reedhead patent expressly teaches a high tension stringing designed to distort -- or flex in the language of the Reedhead patent -- the frame.

For instance, the Reedhead patent states:

Normally the string is inserted at a desired maximum tension. However this tension slowly decreases over a period of usage of the racquet. Therefore a means of continually varying the adjustment of the tension of the strings at a given moment is desirable. Col. 1, lines 8-14.

Restated, the racket is strung at a maximum tension and then when it loses tension over time, the string tension is readjusted to its maximum tension. Clearly this Reedhead racket is not a low tension racket.

As another example, the Applicants note that Reedhead state:

as shown in FIG. 2 . . . causing tightening of the stringing 40. Col. 5, lines 45 - 49.

Again, contrary to the Examiner's assertion, the Reedhead racket is not a low tension racket.

With respect to distortion -- flexion -- of the frame, we note the claimed subject matter is adapted "to completely eliminate distortion." *E.g.*, Claim 1. This subject matter is in marked contrast to Reedhead, which concludes by summarizing its teachings as a:

novel configuration of the stringing of the present invention in combination with the novel racquet head configuration provide *increased flexing* of the racquet . . . [T]he present invention . . . provide[s] a tennis racquet having *increased lateral and longitudinal flexing* characteristics. Col. 6, lines 10 - 29 (emphasis added).

Thus, the Reedhead patent expressly discloses a racket that is neither low tension nor distortion free. Rather, the Reedhead patent expressly discloses a racquet head having increased flexing - distortion. Consequently, the Reedhead patent does not disclose the claimed

Serial No. 09/749,227

Page 6

low tension, distortion free subject matter. Therefore the present rejection must be withdrawn and the claims allowed.


Claims 4-6 and 9 are not rendered obvious by Reedhead

The rejection of claims 4-6 and 9 are predicated upon the incorrect assertions that the Reedhead patent discloses a low tension, distortion free racket. However, as shown above, those assertions are wrong. Therefore the Examiner has not set forth a *prima facie* showing that claims 4-6 and 9 are obvious. Consequently, the rejection must be withdrawn as unfounded and the claims allowed.

The Applicant respectfully submits that the application is in condition for allowance and respectfully solicits the same at an early date. If the Examiner has any further questions, the Applicant requests that the Examiner calls the undersigned.

Respectfully submitted,
COUDERT BROTHERS

By



Walter Scott

Registration No. 30,588

October 22, 2003

COUDERT BROTHERS
1114 Avenue of the Americas
New York, NY 10036-7703
(212) 626-4192 (tel)
(212) 626-4120 (fax)

RECEIVED
CENTRAL FAX CENTER

OCT 22 2003

OFFICIAL